

REMARKS

Claims 1, 3-8, 10-15, and 17-24 are currently pending in this application. Claims 1, 3-6, 8, 10-13, 15, 17-21, and 23 are rejected and claims 7, 14, 22, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant respectfully traverses the rejections and adds new claim 25.

Claim Rejections, 35 U.S.C. §103(a)

Claims 1, 8, and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over O'Neall (USPN 5,267,159) in view of Gustavsson (US 2003/0088348) and further in view of Matsumoto (JP 60208149 A). In addition, claims 4-5, 11-12, 19-20, and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over O'Neall in view of Gustavsson and Matsumoto and in further view of McCann (USPN 6,343,844). Further, claim 17 is rejected under 35 U.S.C. §103(a) as being unpatentable over O'Neall in view of Gustavsson, Matsumoto, McCann, and in further view of Serp (USPN 4,292,624). Finally, claims 3, 10, and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over O'Neall in view of Gustavsson, Matsumoto, McCann, and in further view of Serp or Chang (USPN 5,602,563) or Toumayan (USPN 4,685,116).

Claims 1, 8, and 15

Applicant respectfully submits that the proposed combination is improper because Matsumoto is non-analogous art and there is a lack of the requisite motivation to make the proposed combination.

O'Neall teaches an apparatus including a microprocessor controller for calculating vehicle mileage and a multi-digit LED display for displaying the mileage or speed for each of a plurality of different activities in either miles or feet. O'Neall does not teach or suggest communicating cumulative mileage in the form of a sensory, ON-OFF signal or a series of pulses as recited in claims 1, 8, and 15. Matsumoto teaches outputting a telephone number from memory in the form of Morse Code over a speaker for eyesight handicapped individuals to confirm the registered telephone number (see Abstract and Constitution). Gustavsson merely teaches that an engine electronic control unit may calculate vehicle mileage.

In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then reasonably pertinent to the particular problem with which the invention was concerned. See MPEP 2141.01(a) (citing *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992)). Applicant sought to address the issue of communicating cumulative mileage of a vehicle, such as for example a trailer, for scheduled maintenance without the need to connect to an off-board diagnostic tool having a multi-digit display (see Background section of Applicant's application). An ordinary person seeking to address communicating cumulative mileage without the need to connect an off-board diagnostic tool would not reasonably be expected or motivated to look to a device outputting a telephone's registered number to visually impaired individuals. The device disclosed in Matsumoto is not in the field of applicant's endeavor and addresses an entirely different problem.

In addition, a stated object of O'Neall is providing for a display of current and cumulative mileage for each of a plurality of vehicle activities (see col. 2, lines 6-10). To achieve this object, O'Neall provides a display module (21) having a multi-digit display (46), a plurality of memory selectors (72-80), a mode selector (71), and calibration switches (56, 58). Modifying O'Neall to use the output device of Matsumoto (a speaker for outputting Morse code) or McCann (a light for outputting trouble codes) renders O'Neall unsatisfactory for its intended purpose of having the versatility to display mileage for each of a plurality of activities (in either feet or miles). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). There is not, therefore, any suggestion or motivation to modify the display of O'Neall as proposed in the Office action. Thus, Applicant respectfully submits that independent claims 1, 8, and 15 are patentable over the cited prior art, as are all of the claims that depend therefrom.

New Claim 25

New claim 25 is fully supported by the specification and is patentable over the art of record. None of the cited references teaches or suggests encoding and outputting cumulative mileage of a trailer in the form of an ON-OFF sensory signal to an output device mounted to the trailer.

CONCLUSION

Based on the foregoing remarks and amendments, Applicant believes that all of the claims in this case are now in condition for allowance and an indication to that effect is respectfully requested. Furthermore, if the Examiner believes that additional discussions or information might advance the prosecution of this case, the Examiner should feel free to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

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